

REMARKS

Claims 1-4 remain pending in the above-identified application, with claims 1-2 standing ready for further action on the merits, and claims 3-4 being withdrawn from consideration based on an earlier restriction requirement of the Examiner.

Enclosed 37 CFR § 1.132 Declaration of Mr. Takemura

Enclosed with the instant reply is a 37 CFR § 1.132 Declaration of Mr. Kazuki Takemura, which is being filed in support of the patentability of the instant invention as claimed. The Examiner is respectfully requested to review Mr. Takemura's enclosed declaration at this time as it is submitted to be material to a consideration of the patentability of the instant invention as claimed.

Claim Rejection - 35 USC § 102(b)

Claims 1-2 have been rejected under the provisions of 35 USC § 102(b) as being anticipated by Yamada et al. US '553 (US 4,491,553). Reconsideration and withdraw of this rejection is respectfully requested based on the following considerations.

Incorporation by Reference

Remarks set forth in the prior reply of December 27, 2005 are incorporated herein by reference in their entirety, since they support the patentability of each of pending claims 1-2 (*under consideration at present*) and claims 3-4 (*withdrawn at present*). As such, the Examiner is respectfully requested to review such remarks in their entirety at this time.

Legal Standard for Determining Anticipation

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). "The identical invention must be shown in as complete detail as is contained in the ... claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). The elements must be arranged as required by the claim, but this is not an *ipsisimilis verbis* test, i.e., identity of terminology is not required. *In re Bond*, 910 F.2d 831, 15 USPQ2d 1566 (Fed. Cir. 1990).

Distinctions Over Yamada et al. US 4,491,553

In support of the outstanding rejection, the Examiner states as follows at page 2, line 16 to page 3, line 16 of the outstanding office action.

Previously, the examiner argued that the declaration filed 4/4/05 was not persuasive given that it is not clear what method is used to form the resin composite or why the method appears to be different than that of Yamada et al. The examiner stated that it was not clear why in the declaration the aluminum hydroxide and resin emulsion are first dried and then added to SBR and that it was not clear what, if any, effect drying the aluminum hydroxide/PTFE emulsion mixture would have on the Y/X value of the produced resin composite.

In response, applicant argues that the aluminum hydroxide and resin emulsion were first dried and then added to SBR in light of the disclosure in col. 6, lines 36-40 of Yamada et al. that teach that it is necessary to decrease the moisture content of materials as far as possible in order to obtain shaped articles of good quality.

However, while col. 6, lines 36-40 of Yamada et al. disclose that in order to obtain shaped articles of good quality, it is advantageous to decrease the moisture content as far as possible, this portion of Yamada et al. (col. 6, lines 47-53) further discloses that the mixture operation itself decreases the moisture

content and therefore a pre-drying or pre-heating step is not necessary. Thus, it appears that Yamada et al. teach against using a drying step.

Thus, the examiner's position remains that the declaration is not percussive (sic.) given that the declaration does not provided (sic.) comparison with the "closest" prior art Yamada et al. given that the method of forming the resin composite in the declaration is different than that of Yamada et al.

As such, it appears that the Examiner discounts the earlier filed declaration of April 5, 2005, as not being persuasive, because in the earlier filed declaration aluminum hydroxide and resin emulsion are first dried, which is different from the method of Yamada et al.

Accordingly, in the enclosed 37 CFR § 1.132 Declaration of Mr. Takemura, the "Experiment 1" set forth therein does not utilize such a first drying step of the aluminum hydroxide and resin emulsion (as utilized in the earlier filed declaration). In particular, as set forth in the enclosed declaration, Experiment 1 is set forth as follows:

Experiment 1

13 parts of aluminum hydroxide powder having a crystalline structure of boehmite and an average primary-particle diameter of 13 nm, which was obtained by hydrolysis of aluminum alkoxide, was mixed with 9 parts of PTFE emulsion (trade name: PTFE 30J, PTFE content: 60%, manufactured by Dupont-Mitsui Fluorochemicals Co., Ltd.) in a vessel for 10 minutes to obtain a mixture.

The mixture was mixed for 4 minutes at 100 °C with 87 parts of styrene-butadiene rubber (trade name: HS-1, manufactured by Sumitomo Chemical Co., Ltd.), 1.3 parts of zinc oxide, 1.3 parts of stearic acid, 0.95 parts of an age resistor (trade name: ANTIGENE 3C, manufactured by Sumitomo Chemical Co., Ltd.), and 0.95 parts of wax (trade name: SUNNOC-N, manufactured by Ouchi-Shinko Chemical Industrial Co., Ltd.), and then mixed for 3.5 minutes at 50 °C with 0.64 parts of a vulcanization accelerator (trade name: SOXINOL CZ, manufactured by Sumitomo Chemical Co., Ltd.), 0.64 parts of a vulcanization accelerator (trade name: SOXINOL D, manufactured by Sumitomo Chemical Co., Ltd.), and 0.89 parts of sulfur.

The resultant was subjected to vulcanization molding for 20 minutes by using a 160 °C hot press to obtain a resin composite.

Using the thus obtained resin composite, an index Y/X of the same resin composite was measured in accordance with the procedure set forth in the present specification at page 15, lines 17-25.

As also stated in the enclosed 37 CFR § 1.132 declaration of Mr. Takemura:

The resin composite of the above Experiment 1 possessed an index Y/X of 0.135. It is thus recognized that the resin composite prepared in the above Experiment 1 does not have an index Y/X of 0.1 or less.

Accordingly, based on arguments previously presented in the earlier reply of December 27, 2005, the arguments presented herein, and the comparative testing results provided in the enclosed 37 CFR § 1.132 declaration of Mr. Takemura enclosed herewith, the Examiner is respectfully requested to reconsider and withdraw the outstanding rejection of claims 1-2 over the reference of Yamada et al. US '553. Any contentions of the Examiner and/or USPTO to the contrary are respectfully requested to be reconsidered at present.

Rejoinder Request

Upon allowance of claims 1-2, the Examiner is respectfully requested to rejoin method claims 3-4, which ultimately depend from claim 1.

Provisional Request for Interview

Should the present reply not result in an allowance of at least pending claims 1-2 in the application, the Examiner is respectfully requested to contact Mr. John W. Bailey (Reg. No. 32,881) at the offices of Birch, Stewart, Kolasch & Birch, LLP, at the telephone number indicated below, or at Mr. Bailey's direct work telephone number (703-205-8031) so that a

personal interview can be scheduled with the Examiner at her earliest convenience in, order to resolve issues outstanding relating to the patentability of the claimed invention.

CONCLUSION

Based upon the remarks submitted herewith, the Examiner is respectfully requested to issue a Notice of Allowance clearly indicating that each of the pending claims 1-4 are now in condition for allowance.

Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact John W. Bailey (Reg. No. 32,881) at the telephone number below, to conduct an interview in an effort to expedite prosecution in connection with the present application.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. §§ 1.16 or 1.17; particularly, extension of time fees.

Dated: September 21, 2006

Respectfully submitted,

BIRCH, STEWART, KOLASCH & BIRCH, LLP

By 

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Attachment: 37 CFR § 1.132 Declaration of Mr. Kazuki Takemura